Application No.: 10/609,408 Page 9

Art Unit: 2858

Remarks/Arguments

In paragraph 1 of the Action, Figs. 3a-3c was objected to.

In reply thereto, applicant has corrected as set forth above.

In paragraphs 2-3 of the Action, the abstract of the disclosure was objected to because it contains legal phraseology "comprises". See MPEP 608.01(b).

In reply thereto, applicant reviewed MPEP 608.01(b) but it does not provides "comprises" but "means" and "said".

In paragraphs 4-5 of the Action, claims 1 and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota et al.

In reply thereto, applicant has amended the claims to define applicant's invention more clearly over the prior art of record.

As clearly defined in the amended claims, applicant's invention comprises a plurality of guard rings arranged on the semiconductor substrate such that the guard rings surround the first terminals to cancel the parasitic capacitance generated by the first terminals on the semiconductor substrate.

With respect to the prior art, Hirota et al. disclose a microscopic capacitance measurement system comprising a

Art Unit: 2858

core 72 and a shield 71 to cancel the parasitic capacitance generated between the core 72 and the shield 71.

However, Hirota et al. neither disclose nor suggest any guard ring arranged on the semiconductor substrate, on which the first terminal is provided, to cancel the parasitic capacitance generated by the first terminal. The shield 71 of Hirota et al. is not provided on the semiconductor on which the first terminal is provided but around the core 72. Thus, the system of Hirota et al. fails to cancel the parasitic capacitance generated by the first terminal. Accordingly, it is submitted that applicant's invention as recited in the amended claims is patentable over Hirota et al.

In paragraph 6 of the Action, claims 2-5 were objected to but would be allowable if rewritten in independent form.

In reply thereto, applicant has rewritten claims 2 and 3 in independent form and believes that claims 2-5 are now in condition for allowance.

The number of independent claims after this amendment is three (3) and it is believed that no additional fees are required.

In view of the foregoing, it is respectfully requested that this application be reconsidered, claims 1-6 allowed, and the case passed to issue.

A change of correspondence address is enclosed.

Art Unit: 2858

Respectfully submitted,
TAKEUCHI & TAKEUCHI

By Yusuke Takeuchi

Reg. No. 30,921

Tel (703)684-9777

Application No.: 10/609,408 Page 8

Art Unit: 2858

Amendments to the Drawings:

The attached sheet of drawings includes changes Figs. 3(a) - 3(c). This sheet, which includes Fig. 3(a) - 3(c), replaces the original sheet including Figs. 3(a) - 3(c).

Attachment: Replacement Sheet